

REMARKS / ARGUMENTS

The present application includes pending claims 1-31, all of which have been rejected. Claims 1-2, 8-12, 18-22 and 28-30 have been amended to clarify the claim language for further prosecution. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 1-3, 6-9, 11-13, 16-19, 21-23, 26-29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sampsell (U.S. Patent No. 6,219,839, hereinafter, Sampsell) in view of Replay TV.

Claims 4, 5 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sampsell in view of Griggs (U.S. Publication No. 2002/0053081, hereinafter, Griggs). The Applicant respectfully traverses these rejections at least based on the following remarks.

Rejection Under 35 U.S.C. § 103

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure ("MPEP") states the following:

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure."

See MPEP at § 2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). Further, MPEP § 2143.01 states that “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination,” and that “although a prior art device ‘may be capable of being modified to run the way the apparatus is claimed, there must be a *suggestion or motivation in the reference* to do so’” (citing *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)). Moreover, MPEP § 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the suggestion...,” citing *Al-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

I. The Proposed Combination of Sampsell and Replay TV Does Not Render Claims 1-3, 6-9, 11-13, 16-19, 21-23, 26-29 and 31 Unpatentable

The Applicant now turns to the rejection of claims 1-3, 6-9, 11-13, 16-19, 21-23, 26-29 and 31 under 35 U.S.C. 103(a) as being unpatentable over in view of Replay TV.

A. Rejection of Independent Claims 1, 11, and 21 under 35 U.S.C. § 103(a)

With regard to the rejection of independent claim 1 under 35 U.S.C. § 103(a), the Applicant submits that the combination of Sampsell and Replay TV does not disclose or suggest at least the limitation of “constructing at said first geographical location, at least one display view for display at a second geographic location, said at least one display view indicating the availability of said detected available media,” as recited by the Applicant in independent claim 1. The Office Action states the following:

"With respect to Claim 1, the claimed "A method for presenting available media for selection and playback on a television display, the method comprising: detecting, at a first geographic location, available media at a plurality of different storage locations within said first geographic location; and **constructing at least one display indicating the availability of said detected available media**" is met by Sampsell that teaches the use of a television receiver (12), in conjunction with a user interface, for the selection and playback of available media- whereby available media from a plurality of peripheral devices (VCR #1 14, VCR #2 16, DVD 20, LaserDisc 18) at a 1st location are detected and integrated into an electronic program guide/ electronic resource guide (EPG/ERG) via an electronic resources guide generator (Abstract, Figs.1 & 9; col.2, lines 19-27, col.3, lines 7-15, col.4, lines 5-16, col.5, lines 11-20, col.7, lines 11-18, col.9, lines 53-61)."

See the Office Action at pages 3 (emphasis added). The Examiner equates Sampsell's ERG to be the same as the claimed "constructing at said first geographical location, at least one display view". The Examiner also equates Sampsell's display (via the ERG) of the programming available in the peripheral devices (which are in the active mode) to the claimed "detected available media".

In the Office Action, the Examiner concedes the following:

"However, the (Sampsell) reference is silent with respect to "at said first geographical location for display at a second geographical location," and "communicating at least a portion of said available media from said first geographic location to said second geographic location.

In the similar field of endeavor, ReplayTV teaches constructing "at said first geographical location for display at a second geographical location," and "communicating at least a portion of said available media from said first geographic location to said second geographic location (i.e. sending TV recordings to other replay TV users and accepting recording from other replayTV users)." (Pages 59-61)"

See the Office Action at pages 3 (emphasis added). The Examiner alleges that Replay TV discloses "at said first geographical location for display at a second

geographical location, ... communicating at least a portion of said available media from said first geographic location to said second geographic location," which overcomes Sampsell's deficiency. The Applicant respectfully disagrees and points out that the Examiner seems to have misread the Applicant's claim 1, and therefore relies for support on Replay TV to disclose Sampsell's deficiency incorrectly.

More specifically, the Examiner seems to have overlooked that the Applicant's claimed "**constructing** at said first geographical location at least one **display view**", is "**for display** at a second geographical location". In other words, the Applicant claims that "the second geographical location" displays the same "constructed at least one display view" from the first geographical location. In this regard, the Examiner's argument that Replay TV discloses sending TV recordings to other replay TV users and accepting recording from other Replay TV users (Pages 59-61) does not read on "**for at a second geographical location said** at least one **display view** (of the first geographical location) indicating the availability of said detected available media," as recited claim 1 by the Applicant. Instead, Replay TV discloses sending and accepting media content (i.e., not the claimed "**constructed display view**" of the first geographical location), such as the TV recordings or programs from the TV broadcast station to the recipient Replay TV users. In this regard, the Applicant submits that Sampsell is not combinable with Replay TV, and Sampsell's deficiency is not overcome by Replay TV.

Furthermore, even assuming for the sake of argument that Sampsell's ERG can be combined with Replay TV (which they cannot), the Applicant points out that the combination of Sampsell and Replay TV still does not disclose or suggest at least the limitation of "for display at a second geographic location said at least one display view, for indication of the availability of said detected available media," as recited by the Applicant in independent claim 1.

For example, the Applicant points out that Sampsell's other available programs, which are detected and displayed by the ERG display screen of the sender Replay TV user at the alleged first geographical location, will not be displayed on the recipient Replay TV user at the second geographical location at all. The Examiner is specifically referred to Replay TV at page 61, which discloses that **the recipient Replay TV user** (i.e., at the alleged second geographical location) **sees only the highlighted show** (i.e., the display view) **sent by the sender Replay TV user** (i.e., at the alleged first geographical location). In other words, the display view of the Replay TV user at the first geographical location and the display view of the Replay TV user at the second geographical location are completely different. In this regard, Replay TV still does not overcome Sampsell's deficiency in the claimed "for display at a second geographical location said at least one display view indicating the availability of said detected available media (of the first geographical location)," as recited claim 1 by the Applicant.

Based on the foregoing rationale, the Applicant maintains that the combination of Sampsell and Replay TV does not disclose or suggest at least the limitation of

“constructing at said first geographical location at least one display view, for display at a second geographic location said at least one display view, indicating the availability of said detected available media,” as recited by the Applicant in independent claim 1.

Accordingly, the combination of Sampsell and Replay TV does not establish a prima facie case of obviousness to reject the Applicant's claim 1, and is submitted to be allowable. The Applicant respectfully requests that the rejection to claim 1 under 35 U.S.C. § 103(a) be withdrawn. Independent claims 11 and 21 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 11 and 21 are also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1.

B. Rejection of Dependent Claims 2-3, 6-9, 12-13, 16-19, 22-23, 26-29 and 31

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11, and 21 under 35 U.S.C. § 103(a) as being unpatentable over Sampsell in view of Replay TV has been overcome, and requests that the rejection be withdrawn. Additionally, claims 2-3, 6-9, 12-13, 16-19, 22-23, 26-29 and 31 depend from independent claims 1, 11, and 21, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 2-3, 6-9, 12-13, 16-19, 22-23, 26-29 and 31.

II. Rejection of Dependent Claims 4, 5, 10, 14, 15, 20, 24 and 30 Under 35 U.S.C. § 103(a)

The Applicant turns to the rejection of claims 4, 5, 10, 14, 15, 20, 24 and 30 by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Sampsell and Replay TV in view of Griggs (U.S. Publication No. 2002/0053081, hereinafter, Griggs).

Claims 4, 5, 10, 14, 15, 20, 24 and 30 depend directly or indirectly on independent claim 1, 11 and 21 respectively. Therefore, the Applicant submits that claims 4, 5, 10, 14, 15, 20, 24 and 30 are allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1. In addition, Griggs does not overcome the deficiency of Sampsell.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 4, 5, 10, 14, 15, 20, 24 and 30.

CONCLUSION

Based on at least the foregoing, the Applicant believes that all claims 1-31 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Patent Agent at (312) 775-8093.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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